

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 46320
	:	
Barnaby COURT, et al.	:	Confirmation Number: 6010
	:	
Application No.: 10/675,487	:	Group Art Unit: 2174
	:	
Filed: September 30, 2003	:	Examiner: P. Ke
	:	
For: COMPLEX TABLE RENDERING AND NAVIGATION WITHIN CONSTRAINED DEVICES	:	

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to the EXAMINER'S ANSWER dated February 1, 2008.

The Examiner's response to Appellants' arguments submitted in the Appeal Brief of July 9, 2007, raises additional issues and underscores the factual and legal shortcomings in the Examiner's rejection. In response, Appellants rely upon the arguments presented in the Appeal Brief of July 9, 2007, and the arguments set forth below.

1 **REMARKS**

2
3 At the outset, before addressing the Examiner's response to Appellants' arguments
4 presented in the Appeal Brief, Appellants note that the Examiner has submitted a non-compliant
5 Examiner's Answer. As is evident from the extensive comments presented by Appellants during
6 prosecution of the present Application and in the Appeal Brief, there are questions as to how the
7 limitations in the claims correspond to features in the applied prior art. In this regard, reference
8 is made to M.P.E.P. § 1207.02, entitled "Contents of Examiner's Answer." Specifically, the
9 following is stated:

10 (A) CONTENT REQUIREMENTS FOR EXAMINER'S ANSWER. The examiner's
11 answer is required to include, under appropriate headings, in the order indicated, the following
12 items:
13

14 ...
15 (9)(e) For each rejection under 35 U.S.C. 102 or 103 where there are questions
16 as to how limitations in the claims correspond to features in the prior art even after the
17 examiner complies with the requirements of paragraphs (c) and (d) of this section, the
18 examiner must compare at least one of the rejected claims feature by feature with the
19 prior art relied on in the rejection. The comparison must align the language of the claim
20 side-by-side with a reference to the specific page, line number, drawing reference
21 number, and quotation from the prior art, as appropriate. (emphasis added)

22 However, upon reviewing the Examiner's Answer, Appellants note that lack of a section within
23 the Examiner's Answer that meets the requirements described in the aforementioned section.
24 Thus, the Examiner's Answer is non-compliant and further evidences the Examiner's continued
25 failure to clearly identify the features within the prior art being relied upon by the Examiner in
26 rejecting the claims and continued failure to clearly explain the pertinence of the applied prior
27 art, as required by 37 C.F.R. § 1.104(c).¹

28

¹ 37 C.F.R. § 1.104(c) provides:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Upon reviewing the Examiner's Answer, Appellants note that a new Examiner has taken over the examination of the present application. Moreover, in comparing the statement of the rejection found on pages 2-15 of the Second Office Action with the statement of the rejection found on 3-16 of the Examiner's Answer, Appellants have been unable to identify any substantial changes. Therefore, the Examiner's only response to Appellants' arguments is found on pages 17 and 18 of the Examiner's Answer in the section entitled "Response to Argument."

Of particular note on page 19 of the Examiner's Answer, it was stated that the "examiner's answer contains a new ground of rejection" and referred to section (9) of the Examiner's Answer. However, upon reviewing section (9) (i.e., pages 3-16 of the Examiner's Answer), Appellants have been unable to discern any substantial new ground of rejection.

At the outset, Appellants note that the Examiner has mischaracterized Appellants' arguments. In lines 1-2 on page 17 of the Examiner's Answer, the Examiner characterized Appellants' argument as "Bickmore fails to teach 'a plurality of row range views, a plurality of row views, each of said views having an association with one of said row range views?'" Appellants, however, did not make such a statement in the Appeal Brief. The closest statement to this made in the Appeal Brief is found on page 8 of the Appeal Brief and reproduced below:

On page 4 of the Second Office Action, the Examiner admitted the following as to what Bickmore fails to teach "Bickmore does not teach range row views associated with or linked to record and row views."

Therefore, the Examiner is "responding" to an argument not made by the Appellants. Not only is the Examiner responding to an argument not made by the Appellants, the Examiner did not respond to any of Appellants' arguments as to Examiner's (improper) characterizations of the applied prior art.

In the first full paragraph on page 5 of the Appeal Brief, Appellants made arguments as to the failure of the Examiner to construe a particular limitation and the failure of Polonsky to teach this limitation. The Examiner's response, however, does not address these arguments. In the paragraph spanning pages 5 and 6 of the Appeal Brief, Appellants presented further arguments as to the failure of Polonsky to teach certain limitations. The Examiner's response also does not address these arguments. Additional arguments were presented in the first full paragraph on page 6 and in the paragraph spanning pages 6 and 7 of the Appeal Brief, yet the Examiner's response is also silent as to these separate arguments.

Turning back to the Examiner's "response" on page 17 of the Examiner's Answer, the Examiner included two paragraphs regarding case law as to claim construction. However, the Examiner has not set forth any claim constructions, and as such, Appellants are unclear as to why the Examiner presented this case law.

The Examiner's only new analysis regarding the teachings of the applied prior art as to the claim limitations is found on page 17 of the Examiner's Answer and reproduced below:

In this case, Bickmore teaches a plurality of row range views, a plurality of row views, each of said row views having an association with one of said row range views because Bickmore allows a table to be displayed in a top-down view or left-to-right order. (see Bickmore col. 8 line 66-col.9 line)

This statement appears to contradict the Examiner statement found lines 6-7 on page 5 of the Examiner's Answer and lines 19-20 on page 20 of the Second Office Action that

Bickmore does not teach range row [sic]² views associated with or linked to record and row views.

² The claims do not recite "range row views," but instead "row range views." Therefore, Appellants presume that this is an inadvertent swapping of the terms by the Examiner.

On one hand, the Examiner is asserting that "Bickmore teaches ... each of said row views having an association with one of said row range views," yet on the other hand, the Examiner is asserting "Bickmore does not teach [row range] views associated with ... row views." Notwithstanding the ambiguity as to what the Examiner is asserting that Bickmore teaches or does not teach, reference is made to the Examiner's cited passage of column 8, line 66 through column 9, (presumably) line 9 of Bickmore:

The Table transform recognizes when a table, i.e., the presentation of information arranged in a rectangular grid, on a page cannot be directly sent to the client. In these cases, the Table transform generates one sub-page per table cell, using a top-down, left-to-right order. Tables nested within tables are processed in the same manner. The Table transform uses heuristics to determine when table columns are being used as "navigational sidebars," which is a common practice in commercial HTML web pages. In this case, the Table transform moves these cells to the end of the list of sub-pages, as these cells tend to carry very little content.

Notably absent from this above-reproduced passage cited by the Examiner is any discussion of row range views or row views. Instead, this passage refers to "a page," "one sub page," "table cell," "[t]ables nested in tables," "table columns," and "navigations sidebars." Thus, Appellants respectfully submit that the Examiner's new analysis is not properly grounded in fact.

On pages 7-9 of the Appeal Brief, Appellants addressed the Examiner's obviousness analysis. On page 8, regarding the Examiner's rationale to modify Polonsky in view of Bickmore, Appellants argued that the Examiner has failed to a nexus between the proposed modification to Polonsky based upon the teachings of Bickmore and Examiner's alleged benefit for the modification so as to explain why one having ordinary skill in the art would enjoy a reasonable expectation of achieving this particular asserted benefit based upon the Examiner's proposed modification of Polonsky in view of Bickmore. On page 9, regarding the Examiner's rationale to

1 modify Polonsky in view of Leduc, Appellants presented similar arguments regarding the
2 Examiner's failure to establish a nexus between the proposed modification (i.e., row range views
3 and associated limitations) and the asserted benefit (i.e., "if the table has been parsed ...").
4

5 Turning to pages 17 and 18 of the Examiner's Answer, the Examiner purportedly address
6 these arguments. However, the Examiner again mischaracterized Appellants' argument by
7 asserting that Appellants argued "[t]here is no motivation to combine Polonsky and Bickmore?"
8 This argument was never made by Appellants. In most instances, Appellants recognize that
9 some motivation/common sense rationale can be found to combine teachings in analogous prior
10 art. However, merely identifying a motivation is not enough to establish obviousness of the
11 claimed invention.
12

13 Establishing that one having ordinary skill in the art may have been realistically impelled
14 to combine the applied prior art is not sufficient to establish obviousness of the claimed
15 invention. Depending upon motivation/common sense rationale, the applied prior art may be
16 combined to produce different combinations, some of which teach the claimed invention and
17 some of which do not teach the claimed invention. However, at least one of the possible
18 resulting combinations, based upon the asserted motivation/common sense rationale, must result
19 in the features/limitations, as recited in the claims. Therefore, an obviousness analysis cannot
20 simply end upon establishing that a motivation exists for combining the applied prior art.
21 Instead, the obviousness analysis must establish that the asserted motivation/common sense
22 rationale results in the specific combination being claimed.
23

Appellants' prior arguments were directed to the concept that the obviousness analysis must establish that the asserted motivation/common sense rationale results in the specific combination being claimed. Specifically, a nexus must exist between the proposed modification and the asserted benefit of the modification. For example, if the asserted benefit is achieved by a different modification, then the proposed modification would not be obvious. Instead, the different modification would be obvious. However, as previously argued, the Examiner's analysis has not established this nexus between the proposed modification and the asserted benefit of the modification.

Turning back again to the Examiner's further assertions on pages 17 and 18, the paragraph spanning pages 17 and 18 adds nothing specific to the analysis of particular rejection. Instead, this paragraph recites well-known case law. However, with regard to the asserted rationale for modifying Polonsky in view of Bickmore, the Examiner asserted the following in the first full paragraph on page 18 of the Examiner's Answer:

In this case, Bickmore provided a motivation to combine Polonsky and Bickmore and that is to provide user with "formatting information that defines the layout of the text strings, images, tables and links within the web page." (see Bickmore; col. 6, lines 27-29).

Referring to lines 3-6 on page 5 of the Examiner's Answer and to lines 16-19 on page 4 of the Second Office Action, the Examiner's "response" merely repeats, nearly word-for-word, the Examiner's prior assertions. Thus, the Examiner has not addressed any of the arguments previously presented by Appellants in the Appeal Brief.

After including a discussion by the Supreme Court as to the errors of the Federal Circuit regarding the TSM test on page 18 of the Examiner's Answer, which has no discernable

relevance to the rejections of present application, the Examiner further asserted the following in the last full paragraph on page 18 of the Examiner's Answer:

In the present case, the combination of Polonsky and Bickmore is obvious to one of ordinary skill in the art because it would provide user different format of display table information.

Again, Appellants are unclear as to how the alleged teachings of Biltmore, so as to modify the teachings of Polonsky to arrive at the claimed invention, would result in providing a user with different formats of display table information.

Notably, although Appellants presented arguments regarding the obviousness analysis involving the tertiary reference of Leduc, these arguments were not addressed by the Examiner.

For the reasons set forth in the Appeal Brief of July 9, 2007, and for those set forth herein, Appellants respectfully solicit the Honorable Board to reverse the Examiner's rejection under 35 U.S.C. § 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: April 1, 2008

Respectfully submitted,

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